

REMARKS

In the Final Office Action, the Examiner rejected claims 1-8, 22-35, and 43-55. By this Response, Applicant has amended claims 27, 29, 44, 51, and 55. Upon entry of the amendments, claims 1-8, 22-35, and 43-55 will remain pending in the present patent application. In view of the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

Rejections Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected all of the pending claims under 35 U.S.C. § 103 as obvious in view of various combinations and permutations of the Watanabe reference (JP Reference No. 2000-192135; hereinafter “Watanabe”), the Ulrich et al. reference (U.S. Patent No. 6,229,126; hereinafter “Ulrich”), the Forster reference (U.S. Patent No. 3,873,830; hereinafter “Forster”), the Jancosek et al. reference (U.S. Patent No. 4,845,33; hereinafter “Jancosek”), the Lerg et al. reference (U.S. Patent 6,288,643; hereinafter “Lerg”); the Cachat reference (U.S. Patent No. 3,705,285; hereinafter “Cachat”), and the Ogino et al. reference (U.S. Patent No. 4,456,807; hereinafter “Ogino”). The Examiner’s rejections are addressed in further detail and in turn below.

Applicant respectfully asserts that all pending claims are not obvious in view of the cited references, taken alone or together. First, Applicant respectfully reminds the Examiner that the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). To establish a *prima facie* case, the Examiner must not only show that the combination or modification includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). Moreover, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the

combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Indeed, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990).

Additionally, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *See In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, when prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Indeed, the Federal Circuit has warned that the Examiner must not “fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *See In re Dembiczak* 50 U.S.P.Q. 2d 52 (Fed. Cir.1999). (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir.1983)). Moreover, avoiding hindsight reconstruction is especially important regarding less technologically complex inventions, where the very ease which the invention can be understood may prompt one employ such hindsight. *See id.*

Furthermore, the Federal Circuit has consistently held that a reference that teaches away from the claimed invention cannot serve to create a *prima facie* case of obviousness. *See In re Gurley*, 31 U.S.P.Q.2d 1130, 1132 (Fed. Cir. 1994) (noting that it is a useful general rule that “a reference that ‘teaches away’ can not [sic] serve to create a *prima facie* case of obviousness”). Moreover, a reference must be considered in its entirety, including portions that would lead away from the claimed invention. *See* M.P.E.P. § 2142.02. Indeed, “[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it that will

support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965). With the foregoing precedent in mind, Applicant respectfully asserts that the pending claims are not obvious in view of the cited references.

First Rejection Under Section 103

In the Final Office Action, the Examiner rejected claims 1, 2, 4-7, 22-25, 27, 28, and 43 under 35 U.S.C. § 103(a) as obvious in view Watanabe and Ulrich. Applicant, however, respectfully traverses the rejection.

As a preliminary matter, Applicant addresses the Examiner’s use of Watanabe in the present rejection. Specifically, Applicant notes that the Examiner is relying on a computerized translation that is replete with syntax errors and possible errors in substance. These errors make it difficult to fully appreciate the teachings of Watanabe. Furthermore, Applicant does not concede the correctness of the translation.

In any event, Applicant respectfully asserts that the cited references, with Watanabe taken as it is presented, do not render obvious independent claims 1, 22 and 27 and the claims depending therefrom. Furthermore, Applicant respectfully asserts that cited reference do not render obvious amended independent claims 29, 44, and 51 and the claims depending therefrom. In summary, Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness, because Watanabe teaches away from the claimed subject matter and because the Examiner has employed impermissible hindsight reconstruction to reject the instant claims.

In a general sense, each of claims 1, 22, 27, 29, 44, and 51 recites a flexible fluid-cooled induction heating cable and flow sensor for sensing or monitoring cooling flow for the induction heating cable. The Examiner concedes that neither Watanabe nor Ulrich by itself discloses all of

these features. *See* Final Office Action mailed June 30, 2004, pp. 2-3. Rather, the Examiner asserts that “[i]t would have been obvious to modify Watanabe to use a flexible inductor for its induction hardening system so that the coil can be adapted for objects of different shapes and sizes, in view of the teaching of Ulrich.” *Id.* The Examiner provides no further reasoning or logic for making the proposed modification. Applicant, however, respectfully asserts that the Examiner’s largely conclusory assertion regarding what would have been obviousness is neither correct nor sufficient to support a *prima facie* case of obviousness.

Firstly, Applicant respectfully asserts that nothing in Watanabe suggests that a flexible induction heating system is either desirable or possible. Rather, based on the translation provided by the Examiner, Watanabe discloses a device for the mass production of items *in situ*, suggesting against the need for flexibility. Watanabe states that the disclosed device includes three hardening stations S0, S1, and S2. *See* Watanabe Translation, p. 1, ¶ 3. And each hardening station includes its own coil 100C, 101C, or 102C that is fixed in place and designed to harden the same type product. *Cf. id.* at ¶ 4; FIG. 2 (noting that the each heating coil is illustrated identically). Moreover, the coils each receives resources from the same supply trunk, and these resources purge via the same eccrisis trunk. This commonality of resources and operation further suggests that the Watanabe device is used to mass-produce the same product. *See id.* at ¶¶ 9-11. When producing the same product, it would be desirable to keep the coils 100C-102C static in shape, teaching against the use of flexible induction heating devices. Thus, Watanabe teaches away from the claimed subject matter.

Secondly, Applicant respectfully asserts that nothing in Watanabe or Ulrich suggests the combination suggested by the Examiner. That is, Applicant respectfully asserts that the Examiner has employed impermissible hindsight reconstruction to reject the instant claims. As discussed above, nothing in Watanabe suggests that the disclosed coils 100C-102C would benefit from an ability to change in size or shape. Rather and again, the static, *in situ* nature of the Watanabe device suggests to the contrary.

Applicant respectfully asserts that the Examiner has, at best, employed impermissible hindsight reconstruction to reach the instant claims. As discussed above, in determining the differences between the prior art and the claims, the question under Section 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See Stratoflex, Inc. v. Aeroquip Corp.*, 218 U.S.P.Q. 871 (Fed. Cir. 1983). Thus, the Examiner must not look at each element of a claim individually, but rather the claims should be viewed as a tapestry comprising the recited elements. Moreover, “it is impermissible, however, to simply engage in a hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 18 U.S.P.Q. 2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Simply put, what may seem logical to combine in retrospect and after viewing an applicant’s invention is not obvious unless the cited references, without benefit of this hindsight, teach what is claimed. *See In re Zurko*, 42 U.S.P.Q.2d 1476, 1479 (stating “[w]hile in retrospect, looking at applicants’ invention, it might seem logical to perform a repeat-back in the UNIX system over a trusted line, neither UNIX nor FILER2 teaches communications with the user of a trusted pathway,” as is recited in the claim in question).

Based on the foregoing, Applicant respectfully asserts that the Examiner’s articulated reasoning for combining Watanabe and Ulrich: “it would have been obvious to modify Watanabe to use a flexible inductor for its induction hardening system so that the coil can be adapted for object of different shapes and sizes,” is nothing more than impermissible hindsight reconstruction and, as such, insufficient to support a *prima facie* case of obviousness. Indeed, the Examiner has not articulated how or why the device Watanabe would benefit from a flexible induction device, let alone articulating why one of ordinary skill in the art would find it obvious. Rather, the Examiner relies on Applicant’s disclosure as a roadmap to combine the Watanabe and Ulrich references. That is, the Examiner has not presented any reasoning as to why one of ordinary skill in the art would combine Watanabe and Ulrich to reach the claimed invention

without the benefit of Applicant's application. Indeed, as discussed above, the mere fact that references can be combined is not sufficient to support a *prima facie* case of obviousness.

In summary, the Examiner must not simply pick and choose various elements from various references and present them to an applicant as a rejection. Rather, the claims of an application should be viewed as a tapestry of elements producing a whole, and any obviousness rejection of such claims must demonstrate why one of ordinary skill in the art would find such a tapestry obvious. Applicant appreciates that some hindsight is employable in fashioning an obviousness rejection, but this does not relieve the Examiner of the burden of demonstrating with objective evidence why one of ordinary skill in the art would have found the claimed invention obvious in view of the cited references without the benefit of Applicant's application.

With the foregoing in mind, Applicant respectfully asserts that the Examiner has failed to present a *prima facie* case of obviousness. Applicant respectfully asserts that all pending claims are patentable and in condition for allowance. Furthermore, Applicant respectfully requests reconsideration and allowance of all pending claims.

Second Rejection Under Section 103

In the Final Office Action, the Examiner rejected dependent claim 3 under 35. U.S.C. § 103(a) as obvious in view of Watanabe, Ulrich, Forster. Applicant, however, respectfully traverses the rejection, because Foster does not obviate the deficiencies of Watanabe and Ulrich as discussed above. Accordingly, Applicant respectfully asserts that claim 3 is patentable by virtue of its dependence to allowable independent claim 1 and also by virtue of the additional features recited therein. With the foregoing in mind, Applicant respectfully requests reconsideration and allowance of dependent claim 3.

Third Rejection Under Section 103

In the Final Office Action, the Examiner rejected dependent claims 8 and 26 under 35 U.S.C. § 103(a) as obvious in view of Watanabe, Ulrich and Lerg. Applicant respectfully traverses the rejection.

In a general sense, dependent claims 8 and 26 recite a device or circuit for providing a signal in response to a liquid-cooling flow rate falling below a threshold level. The Examiner concedes that Watanabe and Ulrich fail to disclose this feature, relying on Lerg to obviate this deficiency. Specifically, the Examiner stated that “Lerg shows there are many type of alarms [that] can be used for the purpose of communicating a sensed condition to people such as a member from the group consisting of a bell, a light a horn, a phone device, a wireless communication device, etc. (see col. 2, lines 29-37)” and that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Watanabe to use any well know alarms, including a wireless communication system, such as phone or radio for notifying the user over a longer distance, in view of the teaching of Lerg.” Final Office Action mailed June 30, 2004, p. 4. Applicant, however, respectfully asserts that the Examiner’s reasoning does not support a *prima facie* case of obviousness with respect to the present claims.

As discussed above, the Examiner bears the burden of demonstrating why a claimed invention would be obvious in view of the cited references. In the present case, nothing in Lerg suggests why one of ordinary skill in the art would find it obvious to combine the device of Lerg with that of Watanabe and Ulrich to reach the claimed invention.

In a field wholly divergent from that of Watanabe and Ulrich, Lerg relates to a graffiti detection system. *See* Lerg, col. 1, ll. 15-20; Title. Even if it is accepted that Lerg discloses alarms, this simple fact cannot support a *prima facie* case of obviousness of the instant claims. Indeed, Applicant does not contend that alarms are novel. Rather, it the claimed elements and their interrelationships that Applicant contends as novel, unobvious, and patentable. In other

words, the mere fact that alarms may exist in the prior art is not sufficient reasoning to establish that it would have been obvious to combine such alarms with the flexible, fluid-cooled, induction heating system claimed. Again, the Examiner is relying on impermissible hindsight reconstruction to reject the instant claims, and this will not do.

Fourth Rejection Under Section 103

In the Final Office Action, the Examiner rejected claims 29-34 under 35 U.S.C. § 103(a) as obvious in view of Jancosek, Cachat, and Watanabe. Applicant, however, respectfully asserts that amended claim 29 and the claims depending therefrom are patentable over the cited references, taken alone or together, because the cited references fail to disclose all of the features recited in the instant claims and because the Examiner has failed to present a *prima facie* case of obviousness.

For example, the cited references do not disclose a flexible induction heating device, as recited in amended independent claim 29. Indeed, Applicant's careful review of Jancosek, Cachat, and Watanabe failed to yield any suggestion, let alone reference to flexible devices. Moreover, as discussed above, the *in situ*, mass-production nature of Watanabe teaches against flexible devices.

As another example, the cited references do not disclose "a wheeled cart adapted to transport the fluid cooling unit and the power source to a work piece," as recited in independent claim 29. (Emphasis added.) In rejecting this claim, the Examiner stated that:

Jancosek discloses an induction heating system having a power source (221, 222, 223), a portable fluid cooling unit (shown in Figure 4 connected to a cooling cable 71, see col. 7, lines 33-35), an induction heating device (32), a wheeled cart 58 for the power supply and a system controller (Fig. 1A).

Final Office Action mailed June 30, 2004, p. 5. Furthermore, the Examiner also admitted that the cooling fluid unit is not on the carriage of Jancosek. Specifically, the Examiner stated that:

However, Cachat shows that it is well known in the art to carry the cooling on a wheeled carriage (see Figure 4 and col. 8, line 42-col. 9, line 12). It would have been obvious to modify Jancosek to also carry the fluid cooling unit on the carriage so that the cooling fluids can be supplied to the heating device with better control and ease, in view of Cachat.

Id. at 5.

In contrast to the Examiner's assertions, the combination of Jancosek and Cachat does not disclose or suggest "a wheeled cart adapted to transport the fluid cooling unit and the power source to a work piece," as recited in claim 29. (Emphasis added.) Although Jancosek discloses a movable frame or carriage 58, Jancosek does not disclose a fluid cooling unit on the carriage 58. Instead, the fluid cooling unit of Jancosek is stationary and coupled to the furnace 32 by a suitable flexible electrical supply cable and cooling water conduit 71. *See* Jancosek, col. 7, ll. 33-35.

Thus, in contrast to the Examiner's assertions, the proposed modification to Jancosek would be counter to the specific configuration disclosed in the Jancosek reference. That is, Jancosek teaches a preferred construction, and the Examiner's proposed modification is antithetical to this construction. Furthermore, it is unclear how placing a cooling fluid source on the carriage 58 of Jancosek provides any better control or ease than the existing configuration. In fact, the extra weight of the cooling fluid source would make moving the carriage more difficult to move--not less difficult--teaching away from the Examiner's proposed combination. In other words, decreasing the effective operability of the moving induction coils of the Jancosek device can cause undesirable heating effects, for instance. Indeed, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

Again, a modification is not obvious simply because it can be made. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Clearly, neither the system of Jancosek or the system of Cachat is meant to be moved. Thus, placing more items on the carriage 58 of Jancosek or the carrier 148 of Cachat does not benefit the users of either of these systems. Rather, such a modification detracts from the operability of these cited systems. In this case, the Examiner has provided no evidence from the prior art that suggests the desirability of the combination proposed by the Examiner. Instead, the motivation for the combination is being provided exclusively by the Examiner based on the Examiner's hindsight reconstruction.

With the foregoing in mind, Applicant respectfully asserts that amended independent claim 29 and its respective dependent claims 30-34 are patentable over the cited references. Respectfully, Applicants request reconsideration and allowance of claims 29-34.

Fifth Rejection Under Section 103

In the Final Office Action, the Examiner rejected dependent claim 35 under 35 U.S.C. § 103(a) as obvious in view of Jancosek, Cachat, Watanabe, and Lerg. Applicant, however, respectfully traverses the rejection. In summary, Applicant respectfully asserts that Lerg does not obviate the short comings of Jancosek, Cachat, and Watanabe, as discussed above. Accordingly, Applicant respectfully asserts that dependent claim 35 is patentable by virtue of its dependence from an allowable base claim and also by virtue of the additional features recited therein. Respectfully, reconsideration and allowance of claim 35 is requested.

Sixth and Seventh Rejections Section 103

In the Final Office Action, the Examiner rejected claims 51-54 under 35 U.S.C. § 103(a) as obvious in view of Watanabe and Ogino. Additionally, the Examiner rejected claims 44-50 under 35 U.S.C. § 103(a) as obvious in view of Watanabe, Ogino, and Lerg.

Applicant, however, respectfully asserts that amended independent claims 44 and 51, and the claims depending therefrom, are patentable over the cited references, taken alone or in combination, because the cited references do not disclose all of the features recited in the instant claims and because the Examiner has failed to present a *prima facie* case of obviousness.

For example, the cited references do not disclose a flexible induction heating device, as recited in amended independent claims 44 and 51. Indeed, Applicant's careful review of Ogino and Watanabe failed to yield any suggestion, let alone reference to flexible devices. Moreover, as discussed above, the *in situ*, mass-production nature of Watanabe teaches against flexible devices.

Additionally, neither reference discloses "an alarm system operable to provide an alarm when a signal representative of an improper operating condition in the induction heating power source, or a signal representative of the flow rate of the cooling fluid being below the desired flow rate, or both is received." Similarly, neither cited references suggests, let alone discloses "a communication circuit operable to transmit a *wireless* alarm signal when an improper operating condition exists in the induction heating power source, or the flow of cooling fluid, or both," as recited in independent claim 44.

In rejecting these claims, the Examiner stated that:

Ogino shows that it is well known in the art of induction heating systems to use alarm systems (36, 37) to notify the user when any one of many operating conditions is not proper (39-43) (see Figure 1, col. 4, lines 9-56). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Watanabe to provide alarm (sic) signal when another improper operating condition is detected in addition to a signal representative of the flow rate of the cooling fluid being below a

desired flow rate is received for better information feedback and a safe operation, in view of the teaching of Ogino.

Final Office Action mailed June 30, 2004, pp. 6-7.

Applicant, however, disagrees with the Examiner's assertions. Ogino merely discloses an induction heating *cooking* appliance, while Watanabe discloses a surface hardening device, which is clearly not a cooking appliance. Although Ogino does provide alarms when certain conditions exist, none of these conditions are relevant to the induction heating system of Watanabe. For example, Ogino discloses a cooking appliance that alarms when a pan is heated with no load or an air inlet or outlet is blocked, or the pan is not centered in the heating section of the appliance. *See* Ogino, col. 4, lines 9-34. However, none of these conditions is relevant to the surface hardening induction heating system of Watanabe. Therefore, there is no reason for one skilled in the art to even refer to Ogino, or combine the alarm of Ogino with the system of Watanabe. The Examiner is simply picking and choosing from the references in an attempt to deprecate claim 51. However, this is improper hindsight reconstruction. Furthermore, as noted above, the possibility that some modification may be made to the references to deprecate the claim does not provide the motivation to combine the references or the claimed feature. In this case, there simply is nothing to suggest combining Ogino with Watanabe. Furthermore, even if the references are combined, the references do not disclose all of the recited features of the claim. Accordingly, independent claim 51 is patentable over Watanabe and Ogino.

Similarly, in regard to claim 44, there is no suggestion in the prior art to combine the Lerg with Watanabe and Ogino. As noted above, there is no suggestion in either Watanabe or Ogino for combination. Furthermore, there is nothing in the cited references to suggest combining Lerg with Watanabe and Ogino. Again, Lerg discloses a graffiti detection system, not an induction heating system. Lerg does disclose various alarms, but that is not reason enough to combine the references. Again, there must be something in the references to suggest the desirability of making the modification. That is, the Examiner must provide some objective evidence of

combination other than the final combination it self. There is nothing in any of these references that suggests the desirability of an induction heating system having a “a communication circuit operable to transmit a *wireless* alarm signal when an improper operating condition exists in the induction heating power source, the flow of cooling fluid, or both,” as recited in independent claim 44.

Accordingly, claim 44 is patentable over the cited references. Claims 45-50 and 52-54 depend from independent claims 44 and 51, respectively. Therefore, claims 45-50 and 52-54 also are patentable over the cited references.

Eighth Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claim 55 under 35 U.S.C. § 103(a) as obvious in view of Watanabe and Forster. Applicant respectfully traverses the rejection. In summary, Applicant respectfully asserts that the cited references do not disclose all of the features recited in the instant claims and that the Examiner has failed to present a *prima facie* case of obviousness.

For example, the cited references do not disclose a flexible induction heating device, as recited in amended independent claims 55. Indeed, Applicant’s careful review of Forster and Watanabe failed to yield any suggestion, let alone reference to flexible devices. Moreover, as discussed above, the *in situ*, mass-production nature of Watanabe teaches against flexible devices.

One of the features of claim 55 that is not disclosed or suggested by the cited references is a system controller, “wherein the system controller is operable to control operation of the fluid cooling unit to *increase* the cooling fluid flow rate when the cooling fluid flow rate is below a desired cooling fluid flow rate.” Neither Watanabe, which discloses a coolant system, or Forster,

which does not disclose a coolant system, discloses or suggests a system controller to increase fluid flow when the cooling fluid flow rate is below a desired cooling fluid flow rate.

The Examiner has cited nothing from either of the two references that discloses or suggests a system controller “operable to control operation of the fluid cooling unit to *increase* the cooling fluid flow rate when the cooling fluid flow rate is below a desired cooling fluid flow rate,” as recited in claim 55. The Examiner refers to the “*manual* bulb” of Watanabe, as being able to adjust the flow amount of coolant. However, the *manual* bulb is just that, *manual*. When the flow switch 500 provides an alarm that the flow rate of the coolant is below a set point, the *manual* bulb of Watanabe does not increase cooling fluid flow rate. Furthermore, as noted above, Forster does not disclose an induction heating system or providing a flow of cooling fluid. Of most importance, Forster reference does not disclose or suggest that “to initiate suitable control measures” means adjusting an operating parameter upward, such as increasing the flow rate, as suggested by the Examiner. In fact, the actual recitation “to shut down the welding apparatus or to initiate suitable control measures” more strongly implies a reduction in an operating parameter, such as power, rather than increasing an operating power.

In addition, the Examiner has improperly provided the motivation to combine the references, rather than the prior art. However, as noted above, there must be something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *See Uniroyal Inc.*, 837 F.2d 1044. The motivation to combine the reference cannot come from the Examiner. The Examiner appears to be making the argument that it is obvious to combine the references because they can be combined. However, this too is improper. Even if we assume that the references can be combined, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). In this case, the Examiner has provided no evidence that the prior art suggests the desirability of the combination. Instead, the motivation for the combination is being provided

exclusively by the Examiner. Similarly, even if the modification of the prior art were within the capabilities of one skilled in the art that would not be sufficient by itself to establish a *prima facie* case of obviousness. *See Ex. Parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993).

For all of these reasons, claim 55 is patentable over the Watanabe and Forster references. Reconsideration and allowance and allowance of claim 55 are respectfully requested.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



Date: March 7, 2005

Manish B. Vyas
Reg. No. 54,516
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545